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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,736	10/27/2004	Edwin Zuidema	NL 020383	1761

24737 7590 03/17/2008

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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EXAMINER	
ABEDIN, SHANTO	
ART UNIT	**PAPER NUMBER**
2136	

MAIL DATE	DELIVERY MODE
03/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/512,736	ZUIDEMA, EDWIN	
	Examiner	Art Unit	
	SHANTO M Z ABEDIN	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10/27/2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/26/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the communication filed on 10/27/2004.

2. Claims 1-10 are pending in the application.

3. Claims 1-10 have been rejected.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 10/26/2005 was in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

6. The drawings are objected because the unlabeled rectangular box(es) of figure 5 and figure 6 are missing their descriptive text labels. Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claims 1-10 are objected to because of the following informalities:

8. Regarding claim 1, it recites "if the absence of a watermark has been detected, causing a watermark to be embedded in the content item, and allowing retransmission of the message including the watermarked content item to the intended recipient, and otherwise controlling retransmission of the message including the content item to the intended recipient." However, it is not clear whether such controlling retransmission step is executed as an alternative to the previously recited allowing retransmission step, or at the negation of 'if' statement. For the later case, a negation or switch statement such as "if the absence of a watermark has not been detected" or "if the presence of a watermark has been detected" should be added before the limitation "and otherwise controlling retransmission of the message including the content item to the intended recipient." Appropriate correction is necessary to clearly disclose the metes and bounds of the claimed invention, and avoid future 35 USC 112, second paragraph type rejections. See MPEP 706.03(d) [R-3].

9. Regarding claim 8, it recites "the conditional retransmitting means being arranged for, conditional upon receiving a signal indicating the absence of a watermark, activating watermarking means for embedding a watermark in the content item, and activating retransmitting means for retransmitting the message including the watermarked content item to the intended recipient, and for otherwise controlling retransmission of the message including the content item to the intended recipient." However, it is not clear whether such "and for otherwise" is actually referring to the negation of previously recited "conditional upon" or "retransmitting the message including .." A phrase such as "otherwise upon receiving a signal indicating the presence of a watermark" can be added before the limitations "controlling retransmission of the message including the content item to the intended recipient." Appropriate correction is necessary to clearly disclose the metes and

bounds of the claimed invention, and avoid future 35 USC 112, second paragraph type rejections. See MPEP 706.03(d) [R-3].

10. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In this case, claim 8 from which claims 9 depend on is directed to a machine category patentable subject matter claim, i.e. "a system arranged for controlling retransmission". In accordance with 37 CFR 1.75(c) one or more claims may be presented in dependent form, referring back to and further limiting another claim(s) in the same application. Further, "a claim in a dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers" and requires the dependent claim to further limit the subject matter claimed (see MPEP 2164.08).

In particular, dependent claim 9 does not refer back to and/or further limit the controlling retransmission system, rather these claims refer to and further limits the "media transcoding system", as such these claims are deemed to be in improper dependent form for failing to further limit the claimed subject matter of a previous claim.

11. Claims 2-7 and 10 are objected because of their dependencies on the objected claims.

12. As best understood, claims 1-10 are further examined on their merits, and rejected as below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1- 10 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1- 12 of copending application no. 10/552079.

Although the conflicting claims are not identical, they are not patentably distinct from each other because all the elements/ features of claimed controlling retransmission method/ system of instant application exist in copending application in similar or different names, essentially performing same tasks.

Difference between the conflicting claims of the instant application and that of the copending application is that while the instant application recites steps of detecting and embedding watermark, the claims of copending application fail to recite steps of detecting and embedding watermark. However, the claims of the copending application recite detecting, and embedding approval information in content. An embedded approval information in content item can be interpreted as digital watermark or digital approval seal. Therefore, claims of the instant application are obvious over the claims of the copending application.

This is a provisional obviousness –type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claim 10 is rejected under 35 USC 101 because of being directed to non-statutory subject matter.

Regarding claim 10, it recites a "computer program product" that can be software package or product, or program per se product, therefore, being non-statutory. See MPEP 2106.01

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 1 -10 are rejected under 35 USC 103 (a) as being unpatentable over Nilsen et al (WO 02/103968 A1) in view of Carroni et al (US 6804779 B1)

Regarding claim 1, Nilsen et al teaches a method of controlling retransmission of a content item contained in a multimedia message, the message originating with a sender which received the content item from a provider, comprising:

receiving the message containing the content item from the sender together with an identifier of an intended recipient of the message (Page 8, 10-12; content component or MIME header including receiver identifying information),

processing the content item to detect the presence or absence of a content policy/ specific control information therein (page 5-8; applying/ recognizing content policy/ specific control information),

if the absence of a content policy/ specific control information has been detected,

causing a content policy/ specific control information to be embedded in the content item (page 8; applying content policy/ specific control information to the content), and

allowing retransmission of the message including the content policy/ specific control information content item to the intended recipient (Page 5, 10-11; CCE carries out control of transferred content to receiver),

and otherwise controlling retransmission of the message including the content item to the intended recipient (Page 5, 10-11; CCE carries out control of transferred content).

Although, Nilsen et al teaches applying and detecting "content policy/ specific control information" for controlling the content transmission, it fails to teach expressly applying and detecting 'watermark' for a controlled content transmission.

However, Nilsen et al teaches use of 'watermark' for a controlled content transmission as a prior art. Furthermore, Carroni et al teaches detecting the presence or absence of watermark therein, if the absence of a watermark has been detected, causing a watermark to be embedded in the content item (Col 1, starts at line 60; embedding watermarks in the content), and allowing retransmission of the message including the watermark content item to the intended recipient and otherwise controlling retransmission of the message including the content item to the intended recipient (Col 2, lines 1-25; controlling unauthorized copies by applying watermark in the content)

Carroni et al and Nilsen et al are analogous art because they are from the same field of endeavor of digital content transmission protection. At the time of invention, it will be obvious to a person of ordinary skill in the art to combine the teachings of Nilsen et al 's prior art/ background, or Carroni et al to design a method further comprising detecting and applying watermark in the content to control the transmission in order to provide with a secure alternative content transmission mechanism.

Regarding claim 8, it is rejected applying as same motivation and rationale as applied rejecting claim 1, furthermore, Nilsen et al teaches a system arranged for controlling retransmission of a content item contained in a multimedia message, the message originating with a sender which received the content item from a provider, comprising:

receiving means for receiving the message containing the content item from the sender together with an identifier of an intended recipient of the message (Page 8, 10-12; content component or MIME header including receiver identifying information),

content policy/ specific control information detecting means for processing the content item to detect the presence or absence of a content policy/ specific control information therein, and for signaling to conditional retransmitting means the presence or absence of a content policy/ specific control information (Page 5, 10-11; CCE) ,

the conditional retransmitting means being arranged for, conditional upon receiving a signal indicating the absence of a content policy/ specific control information,

activating content policy/ specific control information means for embedding a watermark in the content item (page 8; applying content policy/ specific control information to the content), and

activating retransmitting means for retransmitting the message including the content policy/ specific control information content item to the intended recipient (Page 5, 10-11; CCE carries out control of transferred content to receiver),

and for otherwise controlling retransmission of the message including the content item to the intended recipient (Page 5, 10-11; CCE carries out control of transferred content).

Although, Nilsen et al teaches means for applying and detecting "content policy/ specific control information" for controlling the content transmission, it fails to teach expressly means for applying and detecting 'watermark' for a controlled content transmission.

However, Nilsen et al teaches use of 'watermark' for a controlled content transmission as a prior art. Furthermore, Carroni et al teaches detecting the presence or absence of watermark therein, if the absence of a watermark has been detected, causing a watermark to be embedded in the content item (Col 1, starts at line 60; embedding watermarks in the content), and allowing retransmission of the message including the watermark content item to the intended recipient and otherwise controlling retransmission of the message including the content item to the intended recipient (Col 2, lines 1-25; controlling unauthorized copies by applying watermark in the content)

Regarding claim 2, it is rejected applying as above rejecting claim 1, furthermore, Nilsen et al teaches the method in which controlling retransmission comprises allowing retransmission of the message including the content policy/ specific control information content item to the intended recipient and billing the sender a premium price (Page 7, 10, 14; charging for billing/ value added content).

Although, Nilsen et al teaches applying and detecting "content policy/ specific control information" for controlling the content transmission, it fails to teach expressly applying and detecting 'watermark' for a controlled content transmission.

However, Nilsen et al teaches use of 'watermark' for a controlled content transmission as a prior art. Furthermore, Carroni et al teaches allowing retransmission of the message including the watermark content item to the intended recipient and otherwise controlling retransmission of the message including the content item to the intended recipient (Col 2, lines 1-25; controlling unauthorized copies by applying watermark in the content)

Regarding claim 3, it is rejected applying as above rejecting claim 2, furthermore, Carroni et al teaches the method in which controlling retransmission comprises allowing retransmission of the message including the watermarked content item to the intended recipient and recording details regarding the retransmission (Col 2, lines 1-25).

Regarding claim 4, Nilsen et al teaches the method in which controlling retransmission comprises restricting retransmission of the message (Page 5, 10-11; CCE carries out control of transferred content).

Regarding claim 5, Nilsen et al teaches the method in which restricting retransmission comprises disallowing retransmission of the message (Page 5, line 11-14). Furthermore, Carroni et al teaches the method in which restricting retransmission comprises disallowing retransmission of the message (Col 2, lines 1-25; controlling unauthorized copies by applying watermark in the content)

Regarding claim 6, Nilsen et al teaches the method in which restricting retransmission comprises allowing retransmission of the message but disallowing retransmission of the content item (Page 11, lines 25-30).

Regarding claim 7, Nilsen et al teaches the method in which retransmission is conditional upon approval by a provider of the content item (Page 1, lines 18-19; third party valued added transmission, and approval)

Regarding claim 9, Nilsen et al teaches a media transcoding system, arranged for transcoding content items in a multimedia message to a format suitable for an intended recipient, comprising the system of claim 8 (Page 12, lines 16-30).

Regarding claim 10, Nilsen et al teaches a computer program product arranged for causing a processor to execute the method of claim 1. (Page 2, 8-10; MMS services)

Conclusion

16. A shortened statutory period for response to this action is set to expire in 3 (Three) months and 0 (Zero) days from the mailing date of this letter. Failure to respond within the period for response will result in ABANDOMENT of the application (see 35 U.S.C 133, M.P.E.P 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 9:00 AM to 5:30 PM. If attempts to reach the examiner by

telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shanto M Z Abedin

Examiner, AU 2136

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2136